

REMARKS

Claims 1-21 were pending in this application. In the non-final office action mailed June 7, 2004:

- 1) the election of claims 1-15 and 17-21 was acknowledged (office action, ¶ 2);
- 2) claim 1 was rejected under 35 U.S.C. § 112, ¶ 2, for lack of antecedent basis (office action, ¶ 3);
- 3) claims 1, 3, 5, 8, 12-14, 17, and 21 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,487,012 (Topholm et al.) (office action, ¶ 4); and
- 4) claims 2, 4, 6, 7, 9-11, 15, and 18-20 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Topholm et al. (office action, ¶ 5).

The claims have been amended and new claims 22-28 are presented. Reconsideration is respectfully requested.

The Invention

A hearing instrument that resides at least partly in the ear canal must be precisely sized to fit properly and avoid creating discomfort for the user. In addition to providing a means for fabricating the instrument by initially creating a virtual representation of the instrument shell, the dimensions of the outer surface of the virtual representation may be further refined to adjust the fit of the instrument in the ear canal.

Rejection under 35 U.S.C. § 112, ¶ 2 (office action, ¶ 3)

The use of the phrase "the step" does not render the claim indefinite or ambiguous; it would be grammatically incorrect without the article "the." Therefore, the claim complies with 35 U.S.C. § 112, ¶ 2.

Rejection under 35 U.S.C. § 102(b) (office action, ¶ 4)

Claims 1, 3, 5, 8, 12-14, 17, and 21 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,487,012 (Topholm et al.). To sustain a rejection based on anticipation under 35 U.S.C. § 102, "the reference must teach every element of the claim." M.P.E.P. § 2131 (8th ed., rev. 2, May 2004), page 2100-73. The M.P.E.P. goes on to state that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," quoting Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Lacking all of the elements set forth in the independent claims, the Topholm et al. reference fails to satisfy this requirement.

The three independent claims contain limitations directed to adjusting the fit of the instrument shell in the ear:

adjusting the fit of the digital representation of the outer surface of the shell in the digital representation of the ear canal [claim 1];

means for adjusting the fit of the digital representation of the outer surface of the shell in the digital representation of the ear canal [claim 17]; and

adjusting the fit of the digital representation of the outer surface of the shell in a digital representation of the ear canal [new claim 28]

Topholm et al. does not disclose, teach, or suggest "adjusting the fit of the digital representation of the outer surface of the shell...." Rather, Topholm et al. discusses changes to the inside of the instrument to accommodate internal components.

During the August 13, 2004 telephone interview, the examiner pointed to the text of Topholm et al. (in the vicinity of column 5, line 40) as anticipating the claims or rendering them obvious. However, examination of the entire paragraph (lines 25-45 of column 5) reveals that this discussion concerns the arrangement and allocation of space within the hearing instrument. Instead of adjusting the fit of the outer surface of the shell in the ear canal - the

applicants' concern, Topholm et al. deals with the fit of components inside the shell, an entirely different problem. Nowhere in this section is there any disclosure, teaching, or suggestion that would lead one skilled in the art to "adjust[] the fit of the digital representation of the outer surface of the shell in the ear canal" (or the outer ear). Therefore, none of the independent claims (1, 17, and new claim 28) are anticipated or rendered obvious by Topholm et al. Similarly, dependent claims 3, 5, and 13 contain similar limitations not anticipated or rendered obvious by the reference. The remaining rejected dependent claims (8, 12, 14, and 21) are allowable for at least the reasons discussed. Newly presented dependent claims 22-27 are also not anticipated by this art.

Rejection under 35 U.S.C. § 103(a) (office action, ¶ 5)

Claims 2, 4, 6, 7, 9-11, 15, and 18-20 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Topholm et al. This rejection cannot be maintained for the same reason as set forth above with respect to the rejection of claims 1 and 17 under § 102 -- the reference does not disclose, teach, or suggest "adjusting the fit of the digital representation of the outer surface of the shell in the digital representation of the ear canal." Moreover, by admission on page 4 of the office action, Topholm et al. does not teach the limitations of the dependent claims. And merely asserting that "it would have been obvious" to meet those limitations is insufficient to establish obviousness. In re Lee, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002) (Board's affirmance of the PTO's unsupported § 103 rejection reversed).

Since all of the claim limitations are not taught or suggested by the cited art, obviousness has not been established. M.P.E.P. § 2143.03 (8th ed., rev. 2, May 2004), p. 2100-133, p. 2100-128 ("[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art"), citing In re Royka,


490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974) [emphasis in original]. Because the reference fails to teach all of the claimed elements, it does not support a finding of obviousness. Additionally, there is no suggestion or teaching in the reference to modify it in such a manner that would result in the claimed invention.

Conclusion

The applicants believes that it has responded to all of the issues raised in the office action and submit that all of the pending claims are allowable. Thus, it is respectfully requested that the examiner pass the application to allowance. The examiner is invited to call the undersigned if there are any questions concerning the application.

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Respectfully submitted,


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